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EXAMINER

HANNAHER, CONSTANTINE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20040927

Application Number: 09/667,826
Filing Date: September 21, 2000
Appellant(s): CANNATA ET AL.

Mark F. Harrington
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

Pursuant to the Remand under 37 CFR 1.193(b)(1) by the Board of Patent Appeals and Interferences on August 1, 2003, a supplemental Examiner's Answer is set forth below:

No changes are made to sections (0) through (9) of the Examiner's Answer mailed November 1, 2002.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 40-50 and 52-58 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The claims of both the original patent and the reissue application are drawn to an apparatus for an infrared imaging system and an infrared focal plane array comprising infrared detectors, readout circuit, correction circuit, and output means. In the original application claims 1-57 as filed included independent claim 1 drawn to an apparatus for an infrared imaging system, independent claims 29 and 42 drawn to an infrared focal plane array, and independent claim 54 drawn to a method for reading out infrared detection signals.

In the first Office action the examiner rejected claims 1, 5-7, 9-13, 21-23, 25, 29-32, 38-44, and 46-57 under 35 U.S.C. 102(e) as being anticipated by Lung or by Masarik *et al.* or as being obvious under 35 U.S.C. 103(a) in view of Lung or in view of Masarik *et al.* Claims 2-4, 8, 14-20, 24, 26-28, 33-37, and 45 were objected to as being allowable dependent claims.

In response to that first action, applicant cancelled claims 1, 23, 29-32, and 42-57¹, and amended claims 2, 5, 7, 9, 10, 12, 13, 21, 24-26, 33, 37, 38, and 41 to place the claims in independent form or dependent on an independent claim. Claims 2, 24, 33, and 37 became independent claims and these claims were renumbered upon allowance on December 9, 1997 to become respectively the claims 1, 26, 27, and 35 of U.S. Patent 5,811,808 sought to be reissued.

In the remarks accompanying the September 9, 1997 amendment, applicant stated, "The Examiner indicated that claims 2-4, 8, 14-20, 24, 33-37 and 45 would be in condition for allowance if rewritten in independent form." Claims 2, 24, and 37 as filed each contained a limitation of (a) a readout circuit wherein each offset correction circuit comprises a plurality of **parallel connected** circuit elements (or current sources) which, when placed in independent form by incorporating the limitations of claims 1, 23, and 29-31, respectively and as filed, provided claims of varying scope all including limitation (a). Claim 33 as filed contained a limitation of (b) a means for correcting which comprises a plurality of **capacitors** connected between the sample node and a reference voltage which, when placed in independent form by incorporating the limitations of claims 29-31 as filed provided claims of varying scope all including limitation (b).

The reissue claims 40, 52, and 58 delete the (a) limitation (**parallel connected**) from the patent claims and do not add the (b) limitation (**capacitors**). The reissue claim 53 deletes the (b) limitation (**capacitors**) from the patent claims and does not add the (a) limitation (**parallel capacitors**). Thus claims 40, 52, 53, and 58 contain neither of the two limitations.

In the original application for patent, the claims which were rejected by the examiner based on prior art did not contain either of the limitations (a) or (b). The applicant made the choice of

¹ The reply submitted September 9, 1997 requested the cancellation of claim 58 as well, but in view of the renumbering under 37 CFR 1.126 as specified in the first paragraph of the Examiner's action, the highest-numbered claim was 57.

amending the original application claims to include at least one of the two key limitations (a) and (b) for all of the claims that were allowed in the patent. The applicant chose not to prosecute variations of the original application claims omitting both (a) and (b). At the present, on reissue, applicant is not permitted to completely omit (in the claims rejected based on recapture) both of these limitations that were relied upon for patentability. See *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001). Additionally, the whole record of the prosecution clearly indicates applicant to have argued that these additional features of key limitations (a) and (b) were not disclosed or taught in the prior art of record.

The rejection of claims 40-50 and 52-58 under 35 U.S.C. 112, first paragraph, as set forth in the Examiner's Answer mailed November 1, 2002, is maintained.

The rejection of claims 1, 5, 21, 22, 40, 42, and 48 under 35 U.S.C. 102(b) as being clearly anticipated by Hegel, Jr. *et al.* (US004752694A), as set forth in the Examiner's Answer mailed November 1, 2002, is maintained.

The rejection of claims 6, 7, 12, 13, 15, 19, 24, 25, 44, 45, 46, 47, and 50 under 35 U.S.C. 103(a) as being unpatentable over Hegel, Jr. *et al.* (US004752694A), as set forth in the Examiner's Answer mailed November 1, 2002, is maintained.

(11) Response to Argument

The decision in *Ex parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel of the Board) is considered not to be applicable to the facts of this appeal. The claims on appeal entirely omit both of the surrender-generating limitations (*i.e.*, both of the limitation(s) added and argued to define over the art to secure allowance). This is because the claims in the original application were revised such that all of the claims contained either the limitation (a) originally found in claims 2, 24, and 37 or the

limitation (b) originally found in claim 33. The revision placed claims 2, 24, 33, and 37 in independent form to provide variants of all the original claims including either limitation (a) or limitation (b). Further, limitations (a) and (b) were expressly argued by applicant to define over the art (each limitation, without the other).

Applicant cannot then, by reissue, entirely omit both of the limitations added and argued to define over the art to secure allowance. Claims 40-50 and 52-58, therefore, impermissibly recapture what was previously surrendered as set forth in the review of the application prosecution history above.

It is pointed out that no narrowing limitations have been noted as to claims 40-50 and 52-58 which could be argued to compensate for the omission of limitations (a) and (b). However, even if such a narrowing limitation was presented, it would need to be in the area of surrender, *e.g.*, a narrowing "past" what was surrendered, but not as specific (narrow) as that which defined the claims over the art in the original patent (as was the case in *Eggert*).

(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

ch
September 27, 2004

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